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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/008,229
Filing Date: November 30, 2001
Appellant(s): KAMEN ET AL.

Elizabeth A. Almeter
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed May 24, 2010 appealing from the Office action mailed November 24, 2010.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 1-17 and 19-21 are rejected and pending in the application.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the

subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

2002/0104081	Candelore et al.	8-2002
5,801,747	Bedard	9-1998
5,978,043	Blonstein et al.	11-1999
5,635,989	Rothmuller	6-1997
2005/0204392	Ellis et al.	9-2005
6,323,911	Schein et al.	11-2001

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 7-12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 7 recites "One or tangible computer-readable media", wherein appellant's disclosure (see, page 14, [0029]) indicates various examples of a, "computer and/or machine readable media, such as....electrical, optical, acoustical and other forms of propagated signals (e.g. carrier waves, infrared signals digital signals, etc.)". It is further noted that the word tangible is not limited to physical objects. Accordingly it is noted that a computer readable can be tangibly be realized

in the form of electrical, optical, acoustical and other forms of propagated signals.

The claim language therefore in its broadest scope encompasses embodiments of transitory computer readable media, thereby merely reciting signals per se. Since, a signal is not a process, machine, manufacture or composition of matter and therefore not a patentable subject matter. See MPEP § 2106.

Claims 8-12 also recite tangible computer readable media, and are non-statutory for similar reasons. Appellant should amend the claims to include "non-transitory" to overcome the rejection.

Claim 21 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 21 recites the limitation "wherein the predetermined number of times is predetermined prior to providing the first set of categories of broadcast programs" Applicant's disclosure merely discloses that category maybe added based on number of times a content is selected rather than based on length of time a content is selected [0015], however is silent on the number of times being predetermined prior to providing the first set of categories.

Claims 1, 7, 19 and 21, are rejected under 35 U.S.C. 103(a) as being unpatentable over Candelore et al. (US PG Pub. 2002/0104081) in view of Bedard (US Pat. 5,801,747)

With regards to claims 1 and 7, Candalore discloses a method comprising:
Providing a first set of categories of broadcast programs (EPG, see [0020]);
Providing a second set of categories of broadcast programs (favorites list 408, wherein favorite items maybe channels, programs, actors, themes, etc. [0045]);
and

Adding a first category from the first set to the second set of categories of broadcasted programs in response to tuning a broadcast program viewing device to a broadcast program fitting into the first categories a predetermined number of times ([0045]-[0046], list of favorites is based on relative statistics maintained, wherein the relative statistics tracks the number of times a channel, program, actor, director or theme was accessed);

Candalore is silent on wherein the predetermined number of times is greater than 1.

In a related art, Bedard discloses maintaining viewer's favorite programming in a viewer profile array, wherein a profile entry for favorite is created only when a viewing unit for that entry is greater than one (col. 5, lines 7-9). Note that the statistics indicating the number of viewing units of Bedard is analogous to the number of times in the Candalore system.

It would have been obvious to one of ordinary skill in the art to modify the system of Candalore in view of Bedard by including only items with greater than 1 viewing units (i.e. items accessed more than 1 times) in the favorites list, thereby eliminating insignificant program/category/channel accesses from the favorites list.

With further regards to claim 7, Candelore further discloses one or more computer readable media storing instructions that when executed by a processor cause the processor to perform the above method [0041].

With regards to claim 19, Candelore further discloses wherein the first and second sets are located in a set top box [0019].

With regards to claim 21, the system as modified in view of Bedard further comprises a predetermined (i.e. greater than 1 viewing unit as taught by Bedard) number of times (as taught by Candelore) prior to providing the first set of categories of broadcast programs.

Claims 2 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Candelore et al. (US PG Pub. 2002/0104081) in view of Bedard (US Pat. 5,801,747) as applied to claims 1 and 7, respectively, above, and further in view of Blonstein et al. (US Pat. 5,978,043).

With regards to claims 2, and 8, the modified system is silent on the method further comprising removing a second category from the second set upon selecting the second category from the second set.

In an analogous art, Blonstein discloses a method of allowing user to remove an item from a favorites list upon selecting of the item from the second set (col. 12, lines 23-30). Such a method is facilitated in the event user no longer wants an item to be included in the favorites list.

It would have been obvious to one of ordinary skill in the art to further modify the system in view of Blonstein's teachings by allowing a viewer to select an

item in the favorites list to remove the item from the favorites list to facilitate removal of an item user no longer wants to be included in the favorites list.

Claims 3-5 and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Candelore et al. (US PG Pub. 2002/0104081) in view of Bedard (US Pat. 5,801,747) as applied to claims 1 and 7, respectively, above, and further in view of Rothmuller (US Pat. 5,635,989).

With regards to claims 3, and 9, the modified system is silent on the method further comprising removing a second category from the second set upon a broadcast program viewing device not being tuned, for a period of time at least equal to a first predetermined threshold, to at least one broadcast program predetermined to be in the second category from the second set.

In an analogous art, Rothmuller discloses a method of further tracking when a program from a favorites list was tuned to (col. 5, lines 62-65, col. 6, lines 26-31). The system additionally determines that a favorite program has not been tuned to for a predetermined time period and removes program from the favorites list upon such a determination (col. 6 lines 48-54). This helps ensure that favorites list is up to date with user's current favorites rather than older favorites that may no longer be of interest to the user.

It would have been obvious to one of ordinary skill in the art to further modify the system in view of Rothmuller by further tracking when an item was last accessed in a favorites list, and removing items that have not been tuned to for a

predetermined threshold thereby purging older entries that are now irrelevant and ensuring that the favorites list is up to date with user's current viewing trends.

With regards to claims 4 and 10, the modified system is silent on the method further comprising, tuning a broadcast program viewing device to a channel on which a broadcast program predetermined to be in a second category from the second set will be broadcasted within a predetermined threshold of current time.

In an analogous art, Rothmuller discloses of alerting or notifying the user about airing of a program item identified as a favorite within a predetermined threshold of current time (col. 7, lines 39-45), and further allowing the user to tune to the program (col. 8, lines 3-15). By notifying the user when items from favorites list is about to air, the system can indicate to the user desirable programs that are about to air in the near future.

It would have been obvious to one of ordinary skill in the art by further modifying the system in view of Rothmuller by notifying the user of desirable programs that are about to air based on user's favorites list and tuning to the program so that the program can be viewed/recorded.

With regards to claims 5 and 11, the modified system is silent on the method further comprising, tuning a broadcast program viewing device, upon a singular pressing of a button, to a channel on which a broadcast program predetermined to be in a second category from the second set will be broadcasted within a predetermined threshold of current time.

In an analogous art, Rothmuller discloses of alerting or notifying the user about airing of a program item identified as a favorite within a predetermined threshold of current time (col. 7, lines 39-45), and further allowing the user to tune to the program (col. 8, lines 3-15) upon a singular press of a button (i.e. AUTO-TUNE key). By notifying the user when items from favorites list is about to air, the system can indicate to the user desirable programs that are about to air in the near future.

It would have been obvious to one of ordinary skill in the art by further modifying the system in view of Rothmuller by notifying the user of desirable programs that are about to air based on user's favorites list and tuning to the program using an auto-tune button so that the program can be viewed/recorded.

Claims 6 and 12, are rejected under 35 U.S.C. 103(a) as being unpatentable over Candelore et al. (US PG Pub. 2002/0104081) in view of Bedard (US Pat. 5,801,747) as applied to claims 1 and 7, respectively, above, and further in view of Ellis et al. (US PG Pub. 2005/0204382) and Schein et al. (US Pat. 6,323,911).

With regards to claim 6, and 12, the modified system is silent on the method further comprising, verifying adding from the first set to the second set including receiving user input confirming the addition of the first category.

In an analogous art, Ellis discloses a method of when a user tunes to a program, presenting a prompt such as "set this program as a favorite?", responsive to which the program is added to favorites [0081].

In a further analogous art, Schein discloses a method of seeking user designation of specific criteria (e.g.) associated with a program a user considers to be a favorite.

It would have been obvious to one of ordinary skill in the art to modify the system in view of Ellis and Schein's teachings by presenting an on screen prompt to the user asking the user to designate specific criteria for favorites prior to entering it to the favorites list thereby confirming with the viewer the specific criteria/item (e.g. category) of a program to be included in the favorites list.

Claims 13 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Candelore et al. (US PG Pub. 2002/0104081) in view of Ellis et al. (US PG Pub. 2005/0204382) and Schein et al. (US Pat. 6,323,911).

With regards to claim 13, Candelore discloses a system comprising:

a first unit provide a first set of categories of broadcast programs (EPG 4A 406, see [0020]);

a second unit to provide a second set of categories of broadcast programs (favorites list 408, wherein favorite items maybe channels, programs, actors, themes, etc. [0045]) in response to selecting the category ([0003], [0020]) from the first set and tuning a broadcasted program viewing device, for a period of time at least equal to a first predetermined threshold ("certain period of time" [0045]), to at least one broadcasted program predetermined to be in the category from the first set [0045]-[0046],

Candelore discloses that various items (including category) pertaining to a program being viewed can be added to the favorites list. Candelore does not disclose the system comprising, wherein the second unit further includes a user verification wherein a user approves the category from the first set being added to the second set prior to the category being added.

In an analogous art, Ellis discloses a method of when a user tunes to a program, presenting a prompt such as "set this program as a favorite?", responsive to which the program is added to favorites [0081].

In a further analogous art, Schein discloses a method of seeking user designation of specific criteria (e.g.) associated with a program a user considers to be a favorite (col. 12, lines 15-18).

It would have been obvious to one of ordinary skill in the art to modify the system in view of Ellis and Schein's teachings by prompting the user to add a program and designated criteria corresponding to the program to the favorites, after a predetermined time of being tuned to that program, so that favorite list adds only items (e.g. user specified criteria on categories) related to the program that are designated by user. When the user to designates a specific criteria corresponding to the program to be included in favorites upon being prompted, the user approves the category from the first list being added to the second set prior to the category being added.

With regards to claim 20, Candelore further discloses wherein the first and second sets are located in a set top box [0019].

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Candelore et al. (US PG Pub. 2002/0104081) in view of Ellis et al. (US PG Pub. 2005/0204382) and Schein et al. (US Pat. 6,323,911) as applied to claim 13 above, and further in view of Blonstein et al. (US Pat. 5,978,043).

With regards to claim 14, the modified system is silent on the method further comprising removing a second category from the second set upon selecting the second category from the second set.

In an analogous art, Blonstein discloses a method of allowing user to remove an item from a favorites list upon selecting of the item from the second set (col. 12, lines 23-30). Such a method is facilitated in the event user no longer wants an item to be included in the favorites list.

It would have been obvious to one of ordinary skill in the art to further modify the system in view of Blonstein's teachings by allowing a viewer to select an item in the favorites list to remove the item from the favorites list to facilitate removal of an item user no longer wants to be included in the favorites list.

Claims 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Candelore et al. (US PG Pub. 2002/0104081) in view of Ellis et al. (US PG Pub. 2005/0204382) and Schein et al. (US Pat. 6,323,911) as applied to claim 13 above, and further in view of Rothmuller (US Pat. 5,635,989).

With regards to claim 15, the modified system is silent on the method further comprising removing a second category from the second set upon a broadcast program viewing device not being tuned, for a period of time at least equal to a first

predetermined threshold, to at least one broadcast program predetermined to be in the second category from the second set.

In an analogous art, Rothmuller discloses a method of further tracking when a program from a favorites list was tuned to (col. 5, lines 62-65, col. 6, lines 26-31). The system additionally determines that a favorite program has not been tuned to for a predetermined time period and removes program from the favorites list upon such a determination (col. 6 lines 48-54). This helps ensure that favorites list is up to date with user's current favorites rather than older favorites that may no longer be of interest to the user.

It would have been obvious to one of ordinary skill in the art to further modify the system in view of Rothmuller by further tracking when an item was last accessed in a favorites list, and removing items that have not been tuned to for a predetermined threshold thereby purging older entries that are now irrelevant and ensuring that the favorites list is up to date with user's current viewing trends.

With regards to claim 16, the modified system is silent on the method further comprising, tuning a broadcast program viewing device to a channel on which a broadcast program predetermined to be in a second category from the second set will be broadcasted within a predetermined threshold of current time.

In an analogous art, Rothmuller discloses of alerting or notifying the user about airing of a program item identified as a favorite within a predetermined threshold of current time (col. 7, lines 39-45), and further allowing the user to tune to the program (col. 8, lines 3-15). By notifying the user when items from favorites list

is about to air, the system can indicate to the user desirable programs that are about to air in the near future.

It would have been obvious to one of ordinary skill in the art by further modifying the system in view of Rothmuller by notifying the user of desirable programs that are about to air based on user's favorites list and tuning to the program so that the program can be viewed/recorded.

With regards to claim 17, the modified system is silent on the method further comprising, tuning a broadcast program viewing device, upon a singular pressing of a button, to a channel on which a broadcast program predetermined to be in a second category from the second set will be broadcasted within a predetermined threshold of current time.

In an analogous art, Rothmuller discloses of alerting or notifying the user about airing of a program item identified as a favorite within a predetermined threshold of current time (col. 7, lines 39-45), and further allowing the user to tune to the program (col. 8, lines 3-15) upon a singular press of a button (i.e. AUTO-TUNE key). By notifying the user when items from favorites list is about to air, the system can indicate to the user desirable programs that are about to air in the near future.

It would have been obvious to one of ordinary skill in the art by further modifying the system in view of Rothmuller by notifying the user of desirable programs that are about to air based on user's favorites list and tuning to the program using an auto-tune button so that the program can be viewed/recorded.

(10) Response to Argument

The examiner respectfully disagrees that the rejection should be reversed. Only those arguments having been raised are being considered and addressed in the Examiner's Answer. Any further arguments regarding other elements or limitations not specifically argued or any other reasoning regarding deficiencies in a prima facie case of obviousness that the appellant could have made are considered by the examiner as having been conceded by the appellant for the basis of decision of this appeal. They are not being addressed by the examiner for the Board's consideration. Should the panel find that the examiner's position/arguments or any aspect of the rejection is not sufficiently clear or a particular issue is of need of further explanation, it is respectfully requested that the case be remanded to the examiner for further explanation prior to the rendering of a decision. See 37 CFR 41.50(a)(1) and MPEP 1211.

Appellant argues (see Brief, page 4) that, "clearly, electrical, optical, acoustical and other forms of propagated signals do not constitute 'tangible computer-readable media as recited in claim 7'". Examiner respectfully disagrees. The Third College Edition of Webster's New World Dictionary of American English defines tangible as something "that can be understood; definite; objective" and further identifies "perceptible" as its synonym. Both are evidence of tangible describing a non-physical state. As such, tangible computer-readable media need not be limited to merely physical embodiments of the computer readable media as appellant attempts to suggest and therefore encompasses non-physical forms of computer readable media, such as propagated signals that are not an article of manufacture, a machine, a process, or a

composition of matter and therefore directed to non-statutory subject matter.

Appellant argues (see Brief, page 5) that, "at least paragraphs [0014] and [0015] describe...wherein the predetermined number of times is greater than 1". Examiner respectfully disagrees. Appellant's specification discloses (see Disclosure, page 7 [0015]) that, "a category from the first set of categories....is added to a second set of categories...upon tuning a broadcasted program viewing device, for a period of time at least equal to a first predetermined threshold" and additionally discloses that (see Disclosure, page 8, [0015]), "a category may be added based on the number of times...rather than the length of time that such broadcast programs are viewed". Appellant's disclosure is silent on the *number of times* being greater than 1. In order to determine that a program of a category has been viewed greater than 1 time, the system must also remember that it was viewed the first time and appellant's disclosure is simply silent on this matter.

:Appellant argues (see Brief, page 6) that, "a program being a 'most tuned to' program clearly does not constitute a category added to a second set of categories in response to tuning a broadcast program viewing device to a broadcast program fitting into the first category of the first set of categories a predetermined number of times". Examiner respectfully disagrees. Candalore for example discloses (see [0045]) that, "favorite items that can be tracked are....themes" wherein (see [0046]), "a list of favorites based on maintained relative statistics is created automatically". Accordingly Candalore discloses (see [0023]) that a category of a program (i.e. the theme) from a first list (i.e. EPG) is tracked (by maintaining relative statistics) in order to add it to the

favorites list (i.e. second list). Furthermore, Candalore discloses that the system tracks the number of times a theme was tuned to (see [0045]), "the relative statistics can be based on number of times a...theme was directly key entered", wherein the list of favorites is based on the maintained statistics (see [0023]) and therefore based on the number of times viewed. Appellant's arguments (see Brief, page 7) stating that, "Bedard clearly fails to teach or suggest adding a first category from the first set of categories to the second set of categories in response to tuning a device to a broadcasted program fitting into the first category" have been noted, however, as stated above, Candalore is being relied upon for this limitation.

Appellant argues (see Brief, page 7) that, "Bedard describes adding a channel to the list of channels when the channel is viewed for a given period of time" stating (see Remarks, page 7) that, "a length of viewing time as described by Bedard does not constitute a number of times tuned". Appellant's attention is drawn to the fact that Candalore discloses tracking amount of time an item was viewed [0034] or tracking the number of times an item was viewed [0028], [0045] or tracking the number of times item was viewed for a particular time [0045]. Accordingly the viewing unit that is kept track of by Candalore can either be the number of times or the amount of time for which an item was viewed further evidenced by Table 5, col. 2, of Candalore, listing, "Time or # of Times Tuned". Keeping this in mind, Bedard is relied upon for the disclosure of such a viewing unit being greater than 1 in order to add to a "favorites" list.

Appellant argues (see Brief, page 8) that, "Blonstein describes removing a *channel* from a favorites list....however, there is no teaching or suggestion of removing a

category as recited in claims 2 and 8". As discussed above, Candelore discloses the step of a favorites list comprising favorite items such as themes (i.e. categories).

Blonstein discloses the step of removing a favorite item from the favorites list.

Accordingly it would have been apparent to one of ordinary skill in the art at the time of the invention to remove favorite items (as taught by Blonstein) such as a category from the favorites list when the favorites list comprises favorite items such as categories (as taught by Candelore). For similar reasons as discussed above, appellant's arguments (see Brief, page 8) with regards to Rothmuller stating that, "there is absolutely no teaching or suggestion of removing any category, let alone a category from a lists of categories" are found unpersuasive.

Appellant argues (see Brief, page 9) that, "there is absolutely no teaching or suggestion in Candelore of adding a category to a second set and tuning a broadcasted program viewing device for a period at least equal to a first predetermined threshold". Examiner respectfully disagrees. Candelore discloses that favorite items can be tracked based statistics [0028] of number of times a channel is tuned to for a particular period of time [0045] or amount of time intervals a program is viewed [0034]. Also see Table 5, col. 2, of Candelore stating, "*Time or # of Times Tuned*". All of these are examples of adding items to favorites list when a program has been viewed for a predetermined threshold (i.e. the viewing interval), the items comprising themes (i.e. categories, see [0045]).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Usha Raman/

Conferees:

Supervisory Patent Examiner

Christopher Kelley

/Christopher Kelley/

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